



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
Ulrich Khan et al. : Group Art Unit:1614
Serial No.: 09/485,292 : Examiner: Binta Robinson
Filed: 3 May 2000 :

For: NEW EPOTHIOLONE DERIVATIVES, PROCESS FOR THEIR PRODUCTION, AND
THEIR PHARMACEUTICAL USE

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR §§ 1.56, 1.97 and 1.98

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This information disclosure statement is made in accordance with 37 C.F.R. §§ 1.56, 1.97 and 1.98 as follows:

Timing and Fees

- ☐ Under 37 C.F.R. § 1.97(b), no fee or statement is required for filing this information disclosure statement is filed:
- ☐ within three months of the filing date of a national application other than a CPA under § 1.53(d);
 - ☐ within three months of the actual filing date of the national phase of a PCT application; OR
 - ☐ before the mailing of a first substantive office action (including after filing of an RCE).
- ☒ Under 37 C.F.R. § 1.97(c), this information disclosure statement is filed after the periods specified in 37 C.F.R. § 1.97(b), but before the mailing date of:
- ☒ a final rejection under 37 C.F.R. 1.113;
 - ☐ termination of prosecution, e.g. Ex Parte Quayle, M.P.E.P § 609(B)(2);

OR

☐ a notice of allowance under 37 C.F.R. § 1.311; and

is accompanied by:

☐ the statement as specified in 37 C.F.R. § 1.97(e) set out below; OR

☒ a check covering the fee of \$180.00 under 37 C.F.R. § 1.17(p).

☐ Under 37 C.F.R. § 1.97(d), this information disclosure statement is filed after the mailing date of the following actions which have not been withdrawn:

☐ a final action under 37 C.F.R. § 1.113;

☐ termination of prosecution, e.g. Ex Parte Quayle, M.P.E.P § 609(B)(2);
OR

☐ a notice of allowance under 37 C.F.R. § 1.311;

AND is filed on or before payment of the issue fee; AND is accompanied by:

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Statements Under 37 C.F.R. 1.97(e)

☐ Each item of information contained in this information disclosure statement was a first cited in a communication from a foreign patent office in a counterpart foreign application having a mailing date not more than three months prior to the filing date of this information disclosure statement; or

☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and to the knowledge of the undersigned attorney after making reasonable inquiry, no item of information contained in this information disclosure statement was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing date of the information disclosure statement.

Cited Materials

☐ Copies of materials listed but not attached were cited in benefit (35 U.S.C. § 120) ancestor application Serial No. _____, on Form 892 by the Examiner and/or Form 1449 by the applicant; see 37 C.F.R. § 1.98(d).

☐ Copies of materials listed were cited in an international search report dated _____.

☒ Copies of the materials listed are attached.

Non-English Language References

☐ An English-language search report or equivalent paper from a foreign patent office is provided indicating the relevance of the cited reference(s).

☐ A foreign-language search report from a foreign patent office is provided, and pertinent parts are translated substantively below:

X = document of particular relevance when it is taken alone

Y = document of particular relevance when it is combined with another such document

A = document defining the general state of the art

O = non-written disclosure

P = intercalated document

T = document cited to understand the theory or principle underlying the invention

E = patent document which has the benefit of a date earlier than the filing date and which was published only on or after this filing date

D = cited in the application

L = cited for another reason

& = publication of member of same patent family

☐ Translation of other relevant information on foreign search report

Other Information

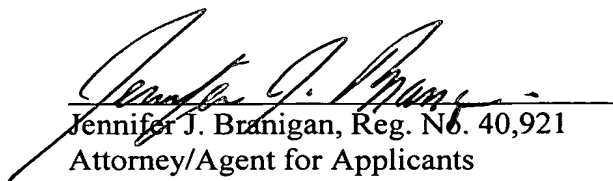
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Respectfully submitted,


Jennifer J. Branigan, Reg. No. 40,921
Attorney/Agent for Applicants

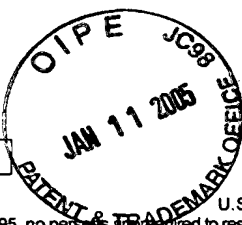
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Attorney Docket No. SCH-1742

Date: January 11, 2005

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet

1

of

2

Complete if Known

Application Number	09/485,292
Filing Date	May 3, 2000
First Named Inventor	Ulrich Klar et al.
Group Art Unit	1614
Examiner Name	Binta M. Robinson
Attorney Docket Number	SCH-1742

U.S. PATENT DOCUMENTS

Examiner Initials *	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code ² (if known)			
		2004/0012735		Sato et al.	1/2004	
		2004/0019088		Lichtner et al.	1/2004	
		2002/0058817		Danishesky	5/2002	
		5,469,145		Schinzer et al.	10/1999	
		6,043,372		Schinzer et al.	3/2000	
		6,156,905		Schinzer et al.	12/2000	
		6,730,699		Li et al.		
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FOREIGN PATENT DOCUMENTS

Examiner Initials *	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ₆
		Office ³	Number ⁴	Kind Code ⁵ (if known)				
		WO	99/02514			1-21-1999		
		WO	99/01124			1-14-1999		
		WO	98/25929			6-18-1998		
		WO	99/67253			12-29-1999		
		WO	99/07692			2-18-1999		
		WO	2004/015088			02-19-2004		

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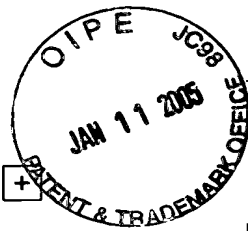
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Sheet 2 of 2

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First Named Inventor	Ulrich Klar et al.
Group Art Unit	1614
Examiner Name	Binta M. Robinson
Attorney Docket Number	SCH-1742

OTHER PRIOR ART -- NON PATENT LITERATURE DOCUMENTS

Examiner Initials *	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		U.S. Serial No. 09/913,163	
		U.S. Serial No. 09/979,939	
		K.C. NICOLAOU ET AL.: "Designed Epothilones: Combinatorial Synthesis, Tubulin Assembly Properties, And Cytotoxic Action Against Taxol-Resistant Tumor Cells" Angewandte Chemie, International Edition, DE. Verlag Chemie. Weinheim, vol. 36, no. 19, 1997, pages 2097-2103, XP002064441	
		K.C. NICOLAOU ET AL.: "Chemical Biology of Epothilones" Angewandte Chemie, International Edition, DE. Verlag Chemie. Weinheim, vol. 37, no. 15, August 1998 pages 2014-2045, XP002131418	
		K.C. NICOLAOU et al.: "Total Synthesis of Oxazole- and Cyclopropane-Containing Epothilone A Analogues by the Olefin Metathesis Approach" - Chem Eur. J. 1997, 3, No. 12, pp. 1957-1970.	
		K.C. Nicolaou, "Synthesis of Epothilones A and B in Solid and Solution Phase", Nature, vol. 387, (1997), pgs 268-272	
		Zhen Yang, et al. "Die Totalsynthese von Epothilone A: der Zugang durch Olefinmetathese ** "Angew. Chem (1997), 109, Nr. 112, pgs 170-172	
		Dieter Schinzer et al., Totalsynthese von (-)-Epothilone A**, "Angew. Chem. 1997, 109, Nr. 5, pgs 543-544	
		K.C. Nicolaou et al., The Olefin Metathesis Approach to Epothilone A and Its Analogs and Chemical Abstracts 26-Biomolecules and Their Synthetic Analogs, Vol. 132, No. 22 (2000), pg. 674	

Examiner Signature		Date Considered	
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